



PILLSBURY WINTHROP

RECEIVED  
CENTRAL FAX CENTER  
OCT 08 2004

FINANCIAL CENTRE 695 EAST MAIN STREET P. O. BOX 6760 STAMFORD, CT 06904-6760 203.348.2300 F: 203.965.8226

## FACSIMILE

Total Pages (including cover): 63

HOUSTON  
LONDON  
LOS ANGELES  
NEW YORK  
NORTHERN VIRGINIA  
ORANGE COUNTY  
SACRAMENTO  
SAN DIEGO  
SAN FRANCISCO  
SILICON VALLEY  
SINGAPORE  
STAMFORD  
SYDNEY  
TOKYO  
WASHINGTON DC

Date: October 8, 2004

Must Be Sent By:

To: U.S. Patent and Trademark  
Office

Fax No: 703-872-9306

Company: Group Art Unit 1624

Phone No:

Confirm:

Confirmed By:

From: Hans-Peter G. Hoffmann

Phone No: (203) 348-2300

User No: 15504

C/M No: BMS-PH-7164(C)  
210830-0306404

Comments:

Re: U.S. Patent Application S/N 10/685,031

## Confidentiality Note:

The documents accompanying this facsimile transmission may contain confidential information which is legally privileged. The information is intended only for the use of the individual or entity named above. If you are not the intended recipient, or the person responsible for delivering it to the intended recipient, you are hereby notified that any disclosure, copying, distribution or use of any of the information contained in this transmission is strictly PROHIBITED. If you have received this transmission in error, please immediately notify us by telephone and mail the original transmission to us. Thank you.

If you have not properly received this fax, please call (203) 348-2300. Thank you.

Operator: \_\_\_\_\_ Time Sent: \_\_\_\_\_ Batch ID: \_\_\_\_\_

Serial No. 10/685,031

Response to Office Action of July 8, 2004;  
BMS PH 7164 (C)  
Page 1 of 62

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Qi Han, et al. Art Unit: 1624  
Serial No.: 10/685,031 Examiner: B. Kifle  
Filing Date: 10/14/2003 Docket No.: BMS-PH-7164 (C)  
Title: **SUBSTITUTED LACTAMS AS INHIBITORS OF A $\beta$  PROTEIN PRODUCTION**

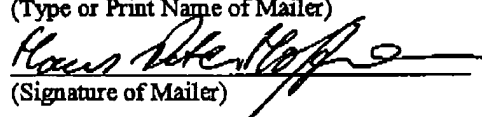
RECEIVED  
CENTRAL FAX CENTER  
OCT 08 2004

**CERTIFICATE OF FACSIMILE TRANSMITTAL**

I hereby certify that this paper is transcribed to Facsimile No. (703) 872-9306 of Group Art Unit 1624, addressed to the Commissioner for Patents, Alexandria, Virginia 22313-1450.

Hans-Peter Hoffmann  
(Type or Print Name of Mailer)

Date: October 8, 2004

  
(Signature of Mailer)

Facsimile No. 703-872-9306  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO OFFICE ACTION OF JULY 8, 2004  
AND AMENDMENT**

Sir:

**INTRODUCTORY COMMENTS**

Applicant respectfully requests entrance of the amendments made herein, and consideration of its arguments set forth below.

Serial No. 10/685,031

Response to Office Action of July 8, 2004;  
BMS PH 7164 (C)  
Page 2 of 62

**Location of Specified Sections for Scanning**

<b><u>SECTIONS OF DOCUMENT</u></b>	<b><u>LOCATION OF SECTION</u></b>
<b>I. INTRODUCTORY COMMENTS</b>	<b>Pages 1 – 3</b>
<b>II. AMENDMENTS TO THE CLAIMS</b>	<b>Pages 4 – 55</b>
AMENDMENTS TO THE SPECIFICATION	N/A
AMENDMENTS TO THE DRAWINGS	N/A
<b>III. REMARKS</b>	<b>Pages 56-62</b>
APPENDIX	N/A

- **Request for Entrance of Response**

Applicants respectfully request that the following amendments be entered, and the remarks set forth below be considered, as responsive to the pending office action in this case, bearing the mailing date of July 8, 2004 ("Office Action").

- **Requests for Extension/ Fees Due**

The response is due October 8, 2004. The Commissioner is hereby authorized to charge any fees due in connection with this paper to Deposit Account 03-3975.

- **Format of this Response**

This response is submitted in compliance with the revised format for making amendments to the specification, claims and drawings officially adopted by the USPTO on July 30, 2003, and which is now reflected in 37 C.F.R. §1.121. Only one version of the claims with markings to show changes are provided in accordance with such regulation (underlining to show additions and strike-through marks or [[ ]] (for deletion of five or less characters) to indicate deleted material). A detailed listing of all claims that are, or were in the application, delineated as either (Original), (Currently Amended), (Canceled), (Withdrawn), (Previously Presented), (New), or (Not Entered), are presented. A complete listing of the claims commence on a separate sheet of this document with the text of "canceled" or "not entered" claims not being

110164606v1

*Serial No. 10/685,031**Response to Office Action of July 8, 2004;  
BMS PH 7164 (C)  
Page 3 of 62*

presented as set forth in the revised rules. Withdrawn claims and claims unamended are shown without mark-up. Concurrent "canceled" or "not entered" claims may be aggregated.

If a substitute specification is submitted herein, a clean form and marked-up version are included. Amendments to drawings, if any, are submitted in compliance with 37 C.F.R. §1.84 on replacement sheets as an attachment to this document (with an accompanying detailed explanation of all of the changes with respect to the drawings made in the remarks section of this amendment).

110164606v1

### AMENDMENT TO THE CLAIMS

#### ▪ Format of Claim Amendments

Applicant has amended the claims as indicated below. Pursuant to the revised format to 37 C.F.R. 1.121 adopted by the USPTO in July of 2003, Applicant herein submits only one version of the claims with markings to show changes. A detailed listing of all claims that are, or were in the application, are presented.

#### ▪ Statement with Respect to Scope of Amended and Non-Amended Claims

Amendments to, cancellation of, and additions to, the claims are made in order to streamline prosecution of the case to embodiments that are presently anticipated to be of commercial significance, and are not made for a purpose of patentability. Any amendment, cancellation or addition made herein should not be construed in any manner as indicating Applicant's surrender of any subject matter of the application, or surrender of any equivalent to any element asserted in one or more claims. Applicant does not concede that the scope of the claims set forth below fail to extend as far as the original claims. Furthermore, any narrowing which may be evinced with respect to subject matter covered by the claims as a whole, or by one or more claims of the appended claims, when compared to claims previously in the application, should not be interpreted as indicating that Applicant has generally disclaimed the territory between the original claimed subject matter and the amended claimed subject matter. Applicant intends each term of the claims set forth below to be read with respect to the full-breadth of the language of the claims and not to be confined to a strict literal read of amended terms. Amended claims elements are to be construed to include substantial equivalents known to those of ordinary skill in the art. Applicant asserts that the amendments are made without prejudice and reserve all rights to prosecute any canceled claims, and claims preceding any amendment, and other disclosed (but not presently claimed) embodiments in the application, in future continuation applications, divisional applications, continuation-in-part applications, continuing prosecution applications, requests for continuing examination, re-examination applications and any other application claiming priority from or through the present application.